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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,459	05/31/2001	Soichi Hayashi	209151US6	6885
22850 7590 01/31/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER PORTER, RACHEL L	
			ART UNIT	PAPER NUMBER
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SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/31/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/867,459

Applicant(s)

HAYASHI ET AL.

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 1/11/06. Claims 1-24 are pending.

Priority

2. Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, it is unclear whether the applicant intends to claim a system or a method the prescription creation system. While the preamble the recites a system comprising, the body of the claim list both system components and method steps.

In *IPXL Holdings, L.L.C. v Amazon.Com, Inc.* (CAFC, 05-1009, -1487, 11/21/2005), the court held a claim covering two statutory classes to be properly rejected under 112,2nd paragraph:

Whether a single claim covering both an apparatus and a method of use of that apparatus is invalid is an issue of first impression in this

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court. The Board of Patent Appeals and Interferences ("Board") of the PTO, however, has made it clear that reciting both an apparatus and a method of using that apparatus renders a claim indefinite under section 112, paragraph 2. *Ex parte Lyell*, 17 USPQ2d 1548 (BPAI 1990). As the Board noted in *Lyell*, "the statutory class of invention is important in determining patentability and infringement." *Id.* at 1550 (citing *In re Kuehl*, 475 F.2d 658, 665 (CCPA 1973); *Rubber Co. v. Goodyear*, 76 U.S. 788, 796 (1870)). The Board correctly surmised that, as a result of the combination of two separate statutory classes of invention, a manufacturer or seller of the claimed apparatus would not know from the claim whether it might also be liable for contributory infringement because a buyer or user of the apparatus later performs the claimed method of using the apparatus. *Id.* Thus, such a claim "is not sufficiently precise to provide competitors with an accurate determination of the 'metes and bounds' of protection involved" and is "ambiguous and properly rejected" under section 112, paragraph 2. *Id.* at 1550-51. This rule is well recognized and has been incorporated into the PTO's Manual of Patent Examination Procedure. § 2173.05(p)(II) (1999) ("A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph."); see also Robert C. Faber, *Landis on Mechanics of Patent Claim Drafting* § 60A (2001) ("Never mix claim types to different classes of invention in a single claim.").

As such, the Examiner is interpreting the claims to mean that the Applicant is claiming a system with a plurality of nodes.

Claims 2-8 inherit the deficiencies of claim 1 through dependency and are also rejected.

The scope of Claim 9 is vague and indefinite, as it is unclear from the preamble and the body of the claim which aspect of the invention the Applicant intends to claim. The preamble recites "a server apparatus connected to..., said apparatus comprising," suggesting that the claim will further define elements of the server apparatus. The body of the claim then recites that the server comprises an outputting means and an executing means.

However, it is noted that the “wherein” clause further defines elements of the nodes, not the server apparatus. Thus it is unclear whether claim 9 is drawn toward the server or the system as a whole.

Claims 10-18 inherit the deficiencies of claim 9 through dependency and are also rejected.

5. Claim 19 recites the limitation “said outputting means” in line. There is insufficient antecedent basis for this limitation in the claim. In particular, claim 9, recites two “outputting means for outputting.” It is not entirely clear from the structure of the claim (see 112, 2nd paragraph rejection of claim 9) which “outputting means” belongs to the server apparatus.

Claim 20 inherits the deficiencies of claim 19 through dependency and is also rejected.

Claim Objections

6. Claims 3,8,10 and 12 are objected to because of the following informalities: It is noted that a number of the claims contain grammatical errors (e.g. errors in subject-verb agreement, missing prepositions). For example, claim 10 recites “wherein the downloading means of the nodes...to check whether or not the condition concerning the insurance product are contrary to predetermined law and order.” Claims 3,8 and 12 recite that the server apparatus performs “at least one processes of...” While the Examiner has provided some examples of the errors, this list is not intended to be complete.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Powers (USPN 5,956,691) in view of Tyler et al (US 5,523,942)

[claim 1] Powers discloses an insurance design service providing system comprising:

- an arbitrary communication network; (Powers: col. 5, lines 30-41)
- a plurality of nodes connected to the arbitrary communication network; and
(Powers: Figure 1: plurality of devices/components)
- a server apparatus configured to output information relating to an insurance product meeting a condition on a basis of the condition input from any of the nodes connected to the arbitrary communication network, (Powers: Figure 1: ref. 44; col. 5, lines 43-61; col. 6, lines 9-24) wherein
 - o the nodes download an insurance fee calculation module, a data storage calling module and a graph drawing module from the server apparatus, (col. 5, lines 30-60; col. 6, lines 9-24)
 - o the nodes execute the insurance fee calculation module to input the condition relating to the insurance product by providing an input screen,

and to calculate an insurance fee on the basis of the input condition and display the insurance fee, (col. 6, lines 9-24; col. 7, lines 1-39; Figures 3-6)

- the nodes execute the data storage calling module when calculating the insurance fee to communicate with a database management module executed by the server apparatus, and to input stored data which is obtained by the database management module by accessing to a database and display the stored data on the input screen in a state correctable for a user, (col. 5, lines 30-60; col. 6, lines 9-24; col. 7, lines 1-39)
- the nodes in accordance with an instruction of the user execute the graph drawing module to display a graph showing transition of at least one of the insurance fee and a guarantee fee according to the input condition, and (Figures 3-6, Figure 7; col. 7, lines 1-39: shows insurance fees according to user input)

Powers discloses the system/method substantially as recited in claim 1, but does not expressly disclose calculating information regarding surrender values, in accordance with user instruction.

Tyler discloses a system/method further comprising:

- the nodes in accordance with an instruction of the user output a request for calculating of a surrender value to the server apparatus, and the server apparatus executes a surrender value calculation module in accordance

with the request to calculate the surrender value and notify a result to the nodes. (col. 20, lines 57-64; col. 30, lines 58-63; col. 31, lines 18-26; col. 32, lines 64-col. 33, line 7)

At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Powers with the teaching of Tyler to include surrender values among the calculations performed in relation to the insurance product. As suggested by Tyler, one would have been motivated to include this feature to simplify the process of providing sales proposals including complex product information and issuing products for insurance agents and sales support. (Tyler: col. 1, lines 35-col. 2, line 24)

[claim 2] Powers discloses the insurance design service providing system according to claim 1, wherein the nodes download a handling definition module from the server apparatus to check whether or not the condition concerning the insurance product are contrary to predetermined law and order, and display a result. (col. 11, line 45-col. 12, line 9—in compliance with regulations and benchmarks)

[claim 3] Powers discloses an insurance design service providing system according to claim 2, wherein said server apparatus performs, with respect to the insurance product based on said inputted condition, at least one processes of examining whether said insurance product meets prescribed regulations, calculating an insurance fee, extracting

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contents of a guarantee, calculating the surrender value, and detecting information regarding accounting processing. (Figure 1,3, 15; col. 6, lines 26-48, col. 7, lines 1-51)

[claim 4] Powers teaches an insurance design service providing system according to claim 2, wherein said server apparatus transmits the graph drawing module to said nodes for graphically displaying information on the result of said each process at said node.

(Figures 1,3-10, col.7, line 58-col. 8, line 32)

[claim 5] Powers teaches the insurance design service providing system according to claim 2, wherein said insurance product is life insurance. (see abstract)

[claim 6] Powers teaches the insurance design service providing system according to claim 5, wherein any of said plurality of nodes inputs prescribed conditions relating to a design of the life insurance into said server apparatus. (Figure 1, col. 6, lines 14-48)

[claim 7] Powers teaches the insurance design service providing system according to claim 6, wherein said server apparatus outputs information relating to the life insurance meeting said inputted conditions. (col. 5, line 43-col. 6, line 8)

[claim 8] Powers teaches the insurance design service providing system according to claim 7, wherein prescribed conditions relating to the design of said life insurance includes at least one of conditions pertaining to age of a policyholder, gender, a payment method of the insurance fee (e.g. premium), a period of payment of the insurance fee (e.g. premium), or contents of a guarantee including an amount insured. (Figures 3-6; col. 7, lines 1-29)

[claim 9] Powers teaches the insurance design service providing apparatus including :

- a server apparatus connected to an arbitrary communication network to which a plurality of nodes are connected (Powers: Figure 1: ref. 44; col. 5, lines 43-61; col. 6, lines 9-24), said server apparatus comprising:
 - a receiving means for receiving prescribed conditions relating to design of prescribed insurance from any said node; (Figure 1, col. 5, lines 31-42)
 - an information generation means for generating information regarding said insurance product meeting said received conditions; and (col. 5, lines 43-61)
 - a transmission means for transmitting said generated information to said node from which said prescribed information is inputted.(col. 5, lines 36-39—communication link/network or the Internet)
 - outputting means for outputting information relating to an insurance product meeting conditions on a basis of the condition input from any of the nodes connected to the arbitrary communication network; and (Powers: Figure 1: ref. 44; col. 5, lines 43-61; col. 6, lines 9-24)
 - wherein the nodes comprise:
 - o downloading means for downloading an insurance fee calculation module, a data storage calling module and a graph drawing module from the server apparatus, (col. 5, lines 30-60; col. 6, lines 9-24)
 - o executing means for executing the insurance fee calculation module to input the condition relating to the insurance product by providing an input screen, and to calculate an insurance fee on the basis of the input condition and display the insurance fee (col. 6, lines 9-24; col. 7, lines 1-39; Figures 3-6)

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- executing means for executing the data storage calling module when calculating the insurance fee to communicate with a database management module executed by the server apparatus, and to input stored data which is obtained by the database management module by accessing to a database and display the stored data on the input screen in a state correctable for a user, (col. 5, lines 30-60; col. 6, lines 9-24; col. 7, lines 1-39)
- executing means for executing in accordance with an instruction of the user the graph drawing module to display a graph showing transition of at least one of the insurance fee and a guarantee fee according to the input condition (Figures 3-6, Figure 7; col. 7, lines 1-39: shows insurance fees according to user input)

Powers teaches the system/method substantially as recited in claim 9, but does not expressly disclose calculating information regarding surrender values, in accordance with user instruction.

Tyler discloses a system/method further comprising:

- executing means for executing a surrender value calculation module, the executing means of the server apparatus executes the surrender value calculation module in accordance with the request to calculate the surrender value and notify a result to the node and wherein nodes comprise outputting means for outputting in accordance with an instruction of the user a request for calculating of a surrender value to the server apparatus. (col. 20, lines 57-64; col. 30, lines 58-63; col. 31, lines 18-26; col. 32, lines 64-col. 33, line 7)

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At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Powers with the teaching of Tyler to include surrender values among the calculations performed in relation to the insurance product. As suggested by Tyler, one would have been motivated to include this feature to simplify the process of providing sales proposals including complex product information and issuing products for insurance agents and sales support. (Tyler: col. 1, lines 35-col. 2, line 24)

[claim 10] Powers discloses an insurance design service providing apparatus according to claim 9, wherein the downloading means of the nodes downloads a handling definition module from the server apparatus to check whether or not the conditions concerning the insurance product are contrary to predetermined law and order, and display a result. (col. 11, line 45-col. 12, line 9—in compliance with regulations and benchmarks)

[claim 11] Powers teaches the insurance design service providing apparatus according to claim 10, wherein said node further comprise generating means for generating insurance specification information on the nodes. (col. 9, lines 1-26)

[claim 12] Powers teaches the insurance design service providing apparatus according to claim 11, wherein said server apparatus further comprises performing means for performing, with respect to the insurance product, based on said inputted condition, at least one of the following processes: examining whether said insurance product meets

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the prescribed regulations, calculating an insurance fee (e.g. premium), extracting contents of a guarantee, calculating a surrender value, and detecting information regarding accounting processing. (Figure 1,3,15; col. 6, lines 26-48, col. 7, lines 1-51)

[claim 13] Powers teaches the insurance design service providing apparatus according to claim 12, wherein the performing means outputs information on the at least one process. (col. 5, lines 43-61; col. 9, lines 25-57)

[claims 14-15] Powers discloses the insurance design service providing apparatus the server apparatus further comprises transmission means and wherein the transmission means causes information about the process to be graphically displayed on a node. (Figures 1,3-10, col.7, line 58-col. 8, line 32)

[claim 16] Powers teaches the insurance design service providing apparatus according to claim 11, further including database means for storing prescribed conditions relating to a design of the insurance product inputted from said nodes. (col. 5, lines 48-61)

[claim 17] Powers teaches the insurance design service providing apparatus according to claim 16, wherein said insurance product is life insurance. (see abstract)

[claim 18] Powers teaches the insurance design service providing apparatus according to claim 17, wherein the server apparatus further comprises receiving means for receiving

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the prescribed conditions relating to the design of the life insurance from said nodes.

(Figure 1, col. 5, lines 31-42)

[claim 19] Powers teaches the insurance design service providing apparatus according to claim 18, wherein said outputting means of the server apparatus outputs information relating to the life insurance meeting said received conditions. (Figure 1, col. 5, lines 31-42; col. 8, lines 65-col. 9, line 62)

[claim 20] Powers teaches the insurance design service providing apparatus according to claim 19, wherein prescribed conditions relating to the design of said life insurance includes at least one of conditions pertaining to age of a policyholder, gender, a payment method of an insurance fee (e.g. premium), a period of payment of an insurance fee (e.g. premium), or contents of a guarantee including an amount insured. (Figures 3-6; col. 7, lines 1-29)

[claim 21] Powers teaches an insurance design service providing method comprising the steps of:

- connecting a server apparatus to a communication network as a web site, wherein a plurality of nodes is connected to said communication network and said server apparatus outputs information relating to an insurance product meeting conditions on a basis of condition input from any of the nodes connected to the communication network;; (Powers: Figure 1: ref. 44; col. 5, lines 30-61; col. 6, lines 9-24)

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- downloading an insurance fee calculation module, a data storage calling module and a graph drawing module from the server apparatus to the nodes; (col. 5, lines 30-60; col. 6, lines 9-24)
- executing the insurance fee calculation module by the nodes to input the condition relating to the insurance product by providing an input screen, and to calculate an insurance fee on the basis of the input condition and display the insurance fee; (col. 6, lines 9-24; col. 7, lines 1-39; Figures 3-6)
- executing the data storage calling module by the nodes when calculating the insurance fee to communicate with a database management module executed by the server apparatus, and to input stored data which is obtained by the database management module by accessing to a database and display the stored data on the input screen in a state correctable for a user; (col. 5, lines 30-60; col. 6, lines 9-24; col. 7, lines 1-39)
- executing the graph drawing module by the nodes in accordance with an instruction of the user to display a graph showing transition of at least one of the insurance fee and a guarantee fee according to the input condition; (Figures 3-6, Figure 7; col. 7, lines 1-39: shows insurance fees according to user input)

Powers discloses the system/method substantially as recited in claim 21, but does not expressly disclose calculating information regarding surrender values, in accordance with user instruction.

Tyler discloses a system/method further comprising:

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- outputting a request for calculating a surrender value from the nodes to the server apparatus in accordance with an instruction of the user; and (col. 20, lines 57-64; col. 30, lines 58-63; col. 31, lines 18-26; col. 32, lines 64-col. 33, line 7)
- executing a surrender value calculation module by the server apparatus in accordance with the request to calculate the surrender value and notify a result to the nodes. (col. 20, lines 57-64; col. 30, lines 58-63; col. 31, lines 18-26; col. 32, lines 64-col. 33, line 7)

At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Powers with the teaching of Tyler to include surrender values among the calculations performed in relation to the insurance product.

As suggested by Tyler, one would have been motivated to include this feature to simplify the process of providing sales proposals including complex product information and issuing products for insurance agents and sales support. (Tyler: col. 1, lines 35-col. 2, line 24)

[claims 22] Powers discloses the insurance design service providing method according to claim 21, wherein,

- said server apparatus transmits to at least one of the nodes the calculation module, the data storage calling module, and graph drawing module, which are relating to the design of said insurance product, when said web site is accessed from any of said nodes; (col. 5, lines 34-39; col. 11, line 59-col. 12, line 11)
- said server apparatus outputs information relating to the insurance product meeting said inputted condition; and (col. 5, lines 43-61)

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- said at least one of the node outputs insurance information by executing said calculation module, the data storage calling module, and graph drawing module, based on said information output from said server apparatus (col. 9, lines 25-col. 10, line 9)

[claim 23] Powers teaches the insurance design service providing method according to claim 22, wherein said insurance product is life insurance (see abstract); and desired information relating to the life insurance meeting condition includes at least one: information items about whether said life insurance meets the prescribed regulations, information about the insurance fee (e.g. calculating a premium), extracting the contents of a guarantee, information about the surrender value (calculating a surrender value), and detecting information regarding accounting processing. (Figure 1,3, 15; col. 6, lines 26-48, col. 7, lines 1-51)

[claim 24] Powers teaches the insurance design service providing method according to claim 22, wherein said insurance is life insurance (see abstract); and wherein prescribed conditions relating to the design of said life insurance includes at least one of conditions pertaining to age of a policyholder, gender, a payment method of the insurance fee(e.g. a premium), a period of payment of the insurance fee (e.g. a premium), or contents of a guarantee including an amount insured. (Figures 3-6; col. 7, lines 1-29).

Response to Arguments

9. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues the newly added limitations. The examiner has added additional citations and a new reference to address the new limitations.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER